

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 2-14 are pending in this case. Claim 1 is canceled without prejudice or disclaimer, Claims 2 and 3 are amended, and new Claims 4-14 are added by the present amendment. Amended Claims 2 and 3 and new Claims 4-14 are supported by the original claims. Amended Claims 2 and 3 and new Claims 4-14 add no new matter.

The specification is objected to for containing informalities. Claims 1-3 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. Claims 1-3 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as anticipated by Ai et al. (U.S. Patent No. 4,909,738, hereinafter "Ai"). Claim 3 was rejected under 35 U.S.C. §103(a) as unpatentable over Ai in view of Neustadter (U.S. Patent No. 2,948,963).

With regard to the objection to the specification, the specification is amended to correct informalities. Accordingly, the objection to the specification is believed to be overcome.

With regard to the rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph, as indefinite, Claim 1 is canceled, mooting this rejection with respect to Claim 1. New Claims 4, 5, 7, 9, 11, and 13 positively recite the claimed elements, using spacing and punctuation to clarify the claimed subject matter. Accordingly, it is respectfully submitted that Claims 2, 3, 4, 5, 7, 9, 11, and 13 are in compliance with all requirements under 35 U.S.C. §112.

With regard to the rejection of Claims 1-3 under 35 U.S.C. §101 as directed to non-statutory subject matter, Claim 1 is canceled, mooting this rejection with respect to Claim 1. New Claims 4, 5, 7, 9, 11, and 13 positively recite the claimed elements, which do not

include a tooth of a human. Rather, Claims 4, 5, and 7 recite a lingual side tooth including a lingual side tooth forming resin material built up on an abutment tooth, and Claims 9, 11, and 13 recite building up a lingual side tooth with a lingual side tooth forming resin material on an abutment tooth. None of the claims positively recite the abutment tooth per se. Thus, it is respectfully submitted that Claims 4, 5, 7, 9, 11, and 13 recite patentable subject matter under 35 U.S.C. §101.

With regard to the rejection of Claim 1 as anticipated by Ai, the rejection is rendered moot by the cancellation of Claim 1. In as much as the rejection may be applied to new independent Claims 4, 5, 7, 9, 11, and 13, the following remarks are respectfully submitted for the Examiner's consideration.

New independent Claim 4 recites a prosthesis for a tooth comprising:

a lingual side tooth including a lingual side tooth forming resin material built up on an abutment tooth, and including a polymer of a mixture of a polymerizable compound having an unsaturated double bond, a filler, and a polymerization initiator; and  
a prosthetic surface having a shape resembling a labial side surface of an anterior tooth, a back surface thereof being attached to said lingual side tooth.

Ai describes an artificial tooth for making dentures.<sup>1</sup> Thus, the artificial tooth is configured to be connected to a retainer or connector.<sup>2</sup> Accordingly, it is respectfully submitted that Ai does not teach "a lingual side tooth including a lingual side tooth forming resin material built up on an abutment tooth," as recited in Claim 4. Further, it is respectfully submitted that Ai does not teach "a prosthetic surface having a shape resembling a labial side surface of an anterior tooth, a back surface thereof being attached to said lingual side tooth." Since Ai does not teach each and every element of Claim 4, Claim 4 is not anticipated by Ai and is patentable thereover.

---

<sup>1</sup>See Ai, column 5, lines 27-30 and column 7, line 15 to column 8, line 22

<sup>2</sup>See Ai, column 6, line 60-61.

Claim 2 is dependent from Claim 4, which applicant believes is patentable. Thus, applicant believes Claim 2 is patentable as well.

With regard to the rejection of Claim 3 as unpatentable over Ai in view of Neustadter, it is noted that Claim 3 is dependent from Claim 4, and thus is believed to be patentable for the reasons discussed above. Further, it is respectfully submitted that Neustadter does not cure any of the above-noted deficiencies of Ai. Accordingly, it is respectfully submitted that Claim 3 is patentable over Ai in view of Neustadter.

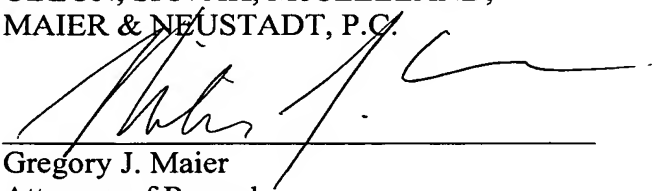
New independent Claims 5, 7, 9, 11, and 13 recite similar elements to Claim 4. It is respectfully submitted that Claims 5, 7, 9, 11, and 13 are patentable over the cited art for the reasons discussed above with respect to Claim 4.

Claims 6, 8, 10, 12, and 14 are dependent from Claims 5, 7, 9, 11, and 13, which applicant respectfully submits are patentable. Thus, Claims 6, 8, 10, 12, and 14 are also believed to be patentable.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
Gregory J. Maier  
Attorney of Record  
Registration No. 25,599

Philip J. Hoffmann  
Registration No. 46,340

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 06/04)